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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,924	05/15/2001	William J. Larkin	13445-102	9466
26486	7590	01/21/2004	EXAMINER	
PERKINS, SMITH & COHEN LLP			PIERCE, JEREMY R	
ONE BEACON STREET			ART UNIT	
30TH FLOOR			PAPER NUMBER	
BOSTON, MA 02108			1771	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,924

Applicant(s)

LARKIN, WILLIAM J.

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on October 17, 2003 has been entered. Claims 1-22 have been amended. New claims 23-28 have been added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1, 6, and 11 recite the wiper material to be "substantially devoid of anti-static properties." This limitation is not supported by the specification. Although the specification does disclose that the wiper material is made from conventional wiper materials, it does not necessarily follow that all conventional wiping materials are substantially devoid of anti-static properties.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, and 11 recite the wiper material to be "substantially devoid of anti-static properties." How much static attraction must there be in a material in order for it to be substantially devoid of anti-static properties?

Regarding claim 1, the phrase "yarn-like" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d). In what way is the material claimed like yarn?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Larkin (U.S. Patent No. 5,690,014).

Larkin discloses a cord comprising woven or braided strands of electrically conductive microfibers and non-conductive fibers, creating an ionizing point network (column 3, lines 40-63). A woven cord material would have structure sufficiently similar to the claimed cloth material of the present invention. The limitation that the cloth be a

wiper is a functional limitation and a statement of intended use that is not material to the product. A cord could be used as a wiper, even if not a very good one. The non-conductive fibers would themselves be devoid of anti-static properties. Although they are woven with conductive fibers to make the overall invention anti-static, the fibers themselves are devoid of anti-static properties, which meets the current claim language. With regard to claim 2, the conductive fibers are present in at least one face (Figure 1). With regard to claim 5, Larkin disclose using cotton, nylon, rayon, or polyester as the non-conductive fiber (column 6, lines 26-29).

8. Claims 1, 3, 5-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada (U.S. Patent No. 5,213,865).

Yamada discloses an anti-static mat that comprises conductive microfibers that project from the surface of the fiber (column 5, lines 1-47 and Figures 3-7). These fibers would create the claimed ionizing point network. The base cloth (column 4, lines 1-4) would form material devoid of anti-static properties since it is made from conventional fibers. The limitation that the cloth be a wiper is a functional limitation and a statement of intended use that is not material to the product. The mat of Yamada could be used as a wiper if desired. With regard to claim 3, the pile fibers are glued onto at least one surface through the backing material (column 8, lines 24-60). With regard to claim 5, the mat may comprise a nylon fabric (column 4, line 2). With regard to claim 6, the surface opposite the piles would be substantially devoid of ionizing points compared to the surface where the piles stick out (see Figure 2). With regard to claims 9 and 10, the base cloth may be nonwoven, mesh, or nylon fabric (column 4, lines 1-3).

9. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein (U.S. Patent No. 3,678,675).

Klein discloses a yarn that is heterogeneously blended from conductive and non-conductive fibers (column 2, lines 55-57). The conductive staple fibers in the yarn would create the claimed ionizing point network. The fibers can be woven along with facing yarns into carpet backing fabric (column 2, lines 64-67). The carpet backing would from material devoid of anti-static properties since it is made from conventional fibers (column 7, line 5). The limitation that the cloth be a wiper is a functional limitation and a statement of intended use that is not material to the product. The mat of Yamada could be used as a wiper if desired. With regard to claim 4, the fibers can be directly tufted into the carpet backing fabric (column 2, lines 64-67). With regard to claim 5, the fiber may be blended with cotton or nylon fibers (column 5, lines 6-59).

Response to Arguments

10. Applicant's arguments filed October 17, 2003 have been fully considered but they are not persuasive.

11. Applicant argues that the Larkin patent is distinguished from the present invention because of the additional limitations of "cloth wiper" or "2-sided cloth wiper." While the Examiner agrees with the latter assertion, the limitation of a "cloth wiper" is only functional. It is basically reciting an intended use of the product and not the product itself. While a cord may not be as efficient a wiper as a 2-sided cloth, the cord of Larkin could be used as a wiper in some form. Applicant's definitions only define

"wiper" as something used for wiping. The references to towels and rags in the definitions seem more of an example of a wiper rather than a definition.

12. Applicant argues that Larkin does not disclose a cloth that is substantially devoid of anti-static properties. However, the presence of conventional fibers would provide material devoid of anti-static properties. Additionally, Applicant claims a cloth wiper that is operably connected to an ionizing point network. It is not entirely clear how the wiper can be devoid of anti-static properties when it is integrally attached to an ionizing point network.

13. Applicant argues that Yamada cannot meet the claimed limitation because a backing material is present in the composite fabric. However, Applicant's claims do not preclude a backing material, so Yamada still meets the claims.

14. Applicant argues that Yamada do not disclose a "cloth wiper." In response, the Examiner would repeat similar arguments cited in section 11 above.

15. Applicant argues that Yamada do not disclose the cloth as being substantially devoid of anti-static properties. However, as set forth above, the base cloth is formed of conventional fibers, and would therefore be devoid of anti-static properties.

16. Applicant argues that the conductive yarn of Klein is exposed on both sides of the backing fabric, and therefore cannot be devoid of the ionizing point network as now claimed. However, Applicant's claim 1 recites that the ionizing point network is placed upon "*at least* one face of the cloth wiper." Since it must appear on at least one face, it can also appear on two faces. So the inclusion of an ionizing point network on another

side of the fabric is not precluded by the claims, even with the limitation that the cloth wiper is made up of fibers that are devoid of anti-static properties.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1771

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0994.

JRP

JRP

Elizabeth M. O'Leary
ELIZABETH M. O'LEARY
PRIMARY EXAMINER